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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/082,036 | 02/20/2002 | Kathleen A. Elias | CYTOP002D1 | 9501 |
| 22434 | 7590 | 05/19/2004 | EXAMINER | |
| BEYER WEAVER & THOMAS LLP P.O. BOX 778 BERKELEY, CA 94704-0778 | | | BRUSCA, JOHN S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1631 | |
| DATE MAILED: 05/19/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------|-------------------------------|------------------------------------|--|
| Advisory Action | Application No. 10/082,036 | Applicant(s) ELIAS, KATHLEEN A. | |
| | Examiner John S. Brusca | Art Unit 1631 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see above.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 24-34, 36-38 and 43.

Claim(s) withdrawn from consideration: 39-42, 44 and 45.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

John S. Brusca 15 May 2004
John S. Brusca
Primary Examiner
Art Unit: 1631

Continuation of 2. NOTE: The applicants state that the proposed amendment to substitute the language "phenotypic fingerprint" for "quantitative phenotypic representations" is equivalent language, and point to discussion in the specification at several points for their conclusion. However, a review of the pointed to discussion shows that the specification discusses phenotypic fingerprints as a species of a quantitative phenotypic representation without providing a requirement that phenotypic fingerprints must comprise data that distinguish the proposed claims from the applied prior art of Hofland et al., Stearns et al., and Zietlow et al. . Each of the applied references show generation of quantitative phenotypic data from cell images. It is not apparent that the proposed amendment distinguishes from the applied prior art because the proposed amendment is drawn to a type of quantitative data that is not limited to be different from the teachings of the cited prior art. If, in arguendo, the proposed amendment distinguishes from the cited prior art, then the proposed amendment would require further search and would not be entered after final rejection.